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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,575	12/05/2003	Kunihiko Kamio	ACO 369	1530
50488	7590	04/21/2005	EXAMINER	
ALLEMAN HALL MCCOY RUSSELL & TUTTLE LLP 806 SW BROADWAY SUITE 600 PORTLAND, OR 97205-3335			VASUDEVA, AJAY	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/728,575

**Applicant(s)**

KAMIO ET AL.

**Examiner**

Ajay Vasudeva

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5 and 8 is/are rejected.
- 7) ☒ Claim(s) 2-4, 6, 7 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Withdrawal of Previous Rejection*

1. The previous rejection of claims 1, 3 and 9 under 35 U.S.C. 102(e) based on Nakagawa et al. has been withdrawn because the reference is disqualified as prior art in view of the applicant's perfecting of the priority. However, this Office action contains a Non-Final rejection based on a new ground

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 05-085462 A ('462).

JP ('462) shows a body structure of a jet propulsion watercraft (figure 1), comprising a body having an inner space defined by a hull and a deck, an engine [30] mounted within the inner space of the body, a water jet pump [31] placed behind the engine and configured to be driven by the engine; and a bulkhead [88] placed behind the engine. The bulkhead is configured to separate the inner space of the body into an engine room [3] on a front side within which the engine is contained, and closed rear spaces [56, 57] on a rear side. In addition to the closed rear spaces, an open rear space [10] is also provided on the rear side of the bulkhead. A first drain hole [7] is provided in the closed rear space of the body so as to communicate with an outside of the watercraft (figure 3).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP ('462) in view of Kelly et al. (US 5,036,789 A).

JP ('462) shows all limitations of claim 1, except the provision of foam structure filled in the interior of the rear space.

Kelly et al. shows a jet propulsion boat with closed cell foam structure filling the interior spaces of the hull so as to provide additional buoyancy and structural strength to the hull (*figure 4; and col. 2, lines 15-25; and lines 39-50*).

It would have been obvious for one skilled in the art at the time of the invention to fill the empty spaces in the hull of JP ('462) – such as the closed rear space of the watercraft -- with the closed cell foam structure, as taught by Kelly et al. Having such foam structure would have advantageously provided additional buoyancy and structural strength to the hull.

Regarding the limitation "the foam structure ... is formed in advance", it is noted that such limitation is a process limitation in an apparatus claim, and is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Therefore, no weight has been given to such limitation because JP ('462), as modified, would possess the recited structure of the foam.

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Furthermore, even if such process limitation were to be given weight, it may be noted that it would have been obvious for one skilled in the art to form the foam structure at least in advance of shipping the jet propulsion boat from the assembly line. Having such foam structure in place in advance of shipping for sale would have properly equipped the boat with good buoyancy as well as structural strength, thereby making it more attractive to prospective buyers.

#### ***Allowable Subject Matter***

6. Claims 2-4, 6, 7 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

7. Applicant's arguments filed with respect to the rejection of claims 1, 3 and 9 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn due to reasons described in ¶ 1 of this Office action.

However, upon further consideration, a new ground of rejection is made in view of JP ('462), as above in ¶ 3 of this Office action.

#### ***Conclusion***

8. The prior art made of record but not yet relied upon is considered pertinent to applicant's disclosure:

- Ito (US 6,077,135 A) shows a bulkhead structure and rear space with a drain hole [67] (figure 3).

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- Schneider (US 5,699,750 A) shows closed cell foam structures filling interior spaces of a hull.
- JP ('689) shows foam structures filling interior spaces of a hull.

9. This is a Non-Final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (571) 272-6689. The examiner can normally be reached on Monday-Friday 12:00 -- 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ajay Vasudeva  
Examiner  
Art Unit 3617

AV

*Ajay Vasudeva*  
**AJAY VASUDEVA**  
**PATENT EXAMINER** 4/18/05